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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,395	09/16/2004	A. John Speranza	03-023	5394
31661	7590	07/26/2006	EXAMINER	
PROTON ENERGY SYSTEM 10 TECHNOLOGY DRIVE WALLINGFORD, CT 06492			RAMILLANO, LORE JANET	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/711,395	SPERANZA ET AL.
	Examiner Lore Ramillano	Art Unit 1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 February 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
 4a) Of the above claim(s) 1-9, 19-27 and 33-43 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 10-18 and 28-32 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 16 September 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/16/05, 12/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a method for maintaining hydrogen purity in an electrical generator, classified in class 436, subclass 55.
 - II. Claims 10-18 and 28-32, drawn to a system for maintaining hydrogen purity in an electrical generator, classified in class 310, subclass 55.
 - III. Claims 19-27 and 33-43, drawn to a system and method for maintaining hydrogen purity in an electrical generator, classified in class 429, subclass 12.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another and materially different apparatus, such as an apparatus that does not contain a hydrogen generator.

3. Inventions of Groups III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

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patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the process as claimed can be practiced by an apparatus that does not contain a hydrogen generator. The subcombination has separate utility such as an apparatus and process that does not contain a purity monitor.

4. Inventions of Groups II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the apparatus as claimed can be used to practice another and materially different process that does not require the steps of releasing the hydrogen gas from an electrical generator at a first rate and generating hydrogen gas at a second rate. The subcombination has separate utility such as an apparatus that does not contain a purity monitor.

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Dave Christensen on 7/17/06 a provisional election was made without traverse to prosecute the invention of Group II, claims 10-18

and 28-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9, 19-27, and 33-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 10-12, 17-18, and 28-30** are rejected under 35 U.S.C. 102(b) as being anticipated by Brosnihan et al. ("Brosnihan," US 2003/0090164).

Brosnihan disclose a system comprising a hydrogen generator (hydrogen-cooled generator, 70, Fig. 2), which is configured to generate hydrogen gas at a predetermined pressure (optimized pressure, [0029]); an electrical generator coupled to the hydrogen generator [0018]; a valve (ie. solenoid valve), which may be operated to release hydrogen gas from the electrical generator in response to a signal from the purity monitor [0024]); a purity monitor (hydrogen gas purity monitoring module, 20, Figs. 2

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and 3); a pressure monitor [0027]-[0028]; a hydrogen purifier (hydrogen gas purity monitoring module monitors hydrogen cooling gas to optimize purity levels, [0020]-[0021]); and a signal is provided by the purity monitor when the purity of the hydrogen gas is lowered [0020]-[0021].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. **Claims 13-16 and 31-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosnihan in view of Werth (US 5510201).

Brosnihan does not specifically disclose having a polymer electrode membrane and having hydrogen gas produced by natural gas.

Werth discloses a system for generating hydrogen fuel for use in an energy-producing device, which utilizes reformed natural gas (columns 7, line 12 to column 9, line 15) and a polymer electrode membrane (proton-exchange membrane, column 11, line 60 to column 12, line 15).

Brosnihan and Werth are analogous art because they are from the same field of endeavor, a system that includes the generation of hydrogen. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Brosnihan with the limitations of Werth, as stated above, because using reformed natural gas for the regeneration process is more cost-efficient compared to other alternative derivatives (column 1, lines 20-34) and using a polymer electrode membrane is particularly suitable for the regeneration process (column 12, lines 7-15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri., 10am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lore Ramillano
Examiner
Art Unit 1743

7/19/06


Jill Warden
Supervisory Patent Examiner
Technology Center 1700